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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,695	04/21/2000	MARVIN T LING	GTX-001	6472
7590	10/04/2003		EXAMINER	
Nicola A Pisano Luce Forward Hamilton & Scripps LLP 11988 El Camino Real Suite 200 San Diego, CA 92130			KANOF, PEDRO R	
			ART UNIT	PAPER NUMBER
			3628	
			DATE MAILED: 10/04/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/553,695	LING, MARVIN T
	Examiner Pedro Kanof	Art Unit 3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 05 June 2003.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-27 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-27 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

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### DETAILED ACTION

1. In view of the Appeal filed on 6/5/03, PROSECUTION IS HEREBY REOPENED.

A new action is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

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Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-14, and 16-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. (U.S. Patent No. 5,815,657) (hereinafter Williams) in view of Briscoe (U.S. Patent No. 6,341,273).

Claims 1 and 27: Williams disclose a method for conducting electronic commerce and a server operated by a vendor that provides products for sale or rental through a network, the server comprising:

a network interface through which the server communicates with a user over the network (Col. 12, lines 41-46);

a database (Col. 14, lines 24-28);

a memory (Col. 13, line 67-col. 14, lines 6);

a processor that executes software stored in the memory (Col. 15, line 61-col. 16, line 4, and col. 16, lines 22-38), the software including one or more programmed routines, the programmed routines comprising:

a registration routine that opens a user account in the database for the user (Col. 2, lines 9-16 and col. 1, lines 31-42);

an electronic token sale routine that issues one or more electronic tokens from the vendor to the user, and adds the one or more electronic tokens to the user account (Col. 1, lines 16-26 and col. 17, lines 49-57). However, Williams does not explicitly

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disclose that the token sale routine that issues tokens from the vendor to the user without requiring communication with a financial institution. Briscoe disclose the feature and step to sale electronic tokens to the user without requiring communication with a financial institution (Col. 1, line 63-col. 2, line 23). Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made to use this step and feature in the Williams method and system. One would have been motivated to use this step and feature in order to facilitate the sales operations and increase its speed.

Williams also discloses a display routine that displays the prices of the products in units of electronic tokens (Col. 1, lines 16-27, col. 2, line 47-col. 3, line 9, col. 11, line 31-Col. 12, line 17, col. 10, line 42-col. 11, line 15, col. 16, lines 5-17, col.17, lines 3-19, col. 22, lines 26-37, and col. 31, lines 2-20);

a selection routine that permits the user to select a subset of the products for purchase without disclosing personal information to the vendor, a total price of the subset of the products being computed in units of electronic tokens (Col. 31, lines 24-40). However, Williams does not explicitly disclose a selection routine that permits the user to select a subset of the products for purchase without disclosing personal information to the vendor. Briscoe disclose the feature and step that permits the user to select a subset of the products for purchase without disclosing personal information to the vendor (Col. 9, lines 19-25). Therefore, it would have been obvious to one

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having ordinary skills in the art at the time the invention was made to use this step and feature in the Williams method and system. One would have been motivated to use this step and feature in order to guarantee the buyer anonymity.

Williams also discloses a purchase routine that determines if the user account contains electronic tokens having a value equal to or greater than the total price, and if so, subtracts the total price from the user account (Col. 1, lines 27-37 and col. 21, line 24-col. 22, line 25).

Claim 2: Williams and Briscoe disclose the method of claim 1. Williams also discloses issuing one or more electronic tokens from the vendor to the user comprises permitting the user to purchase the one or more electronic tokens from the vendor (Col. 17, lines 49-57).

Claim 3: Williams and Briscoe disclose the method of claim 2. Williams also discloses permitting the user to purchase the one or more electronic tokens from the vendor comprises permitting the user to conduct an on-line transaction using a credit card to purchase the one or more electronic tokens (Col. 2, lines 9-17, col. 18, lines 27-30 and claim 21, lines 26-28).

Claim 4: Williams and Briscoe disclose the method of claim 2. Williams also discloses permitting the user to purchase the one or more electronic tokens from the vendor comprises permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens (Col. 2, lines 18-20).

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Claim 5: Williams and Briscoe disclose the method of claim 4. Williams also discloses permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens comprises permitting the user to use a purchase order to purchase the one or more electronic tokens (Col. 2, lines 20-36).

Claim 6: Williams and Briscoe disclose the method of claim 4. However, the references does not explicitly disclose permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens comprises permitting the user to request to be billed for the one or more electronic tokens. Official notice is taken that the step of permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens comprises permitting the user to request to be billed for the one or more electronic tokens is old and well known within the art. One would have been motivated to including this step in order to increase the flexibility of the system.

Claim 7: Williams and Briscoe disclose the method of claim 4. Williams also discloses permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens comprises permitting the user to use phone, fax, mail, or e-mail to purchase the one or more electronic tokens (Col. 1, lines 17-24).

Claim 8: Williams and Briscoe disclose the method of claim 4. Williams also discloses permitting the user to conduct an off-line transaction to purchase the one

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or more electronic tokens comprises permitting the user to purchase electronic tokens without using a credit card (Col. 21, lines 23-28).

Claim 9: Williams and Briscoe disclose the method of claim 1. wherein issuing the one or more electronic tokens comprises setting a price for the one or more electronic tokens, the price determined by the vendor (Col. 15, lines 60-65). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to issuing the one or more electronic tokens comprises setting a price for the one or more electronic tokens, the price determined by the vendor. One would have been motivated to including this step in order to increase the flexibility of the system.

Claim 10: Williams and Briscoe disclose the method of claim 1. Williams also discloses wherein opening a user account with a vendor comprises registering the user with the vendor (Col. 2, lines 9-14).

Claim 11: Williams and Briscoe disclose the method of claim 10. Williams also discloses wherein registering the user with the vendor comprises recording personal information about the user in a database maintained by the vendor (Col. 10, line 65-col. 11, line 4, col. 18, lines 33-37).

Claim 12: Williams and Briscoe disclose the method of claim 11. Williams also discloses wherein registering the user with the vendor comprises acquiring

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personal information about the user through off-line communications (Col. 11, lines 31-38)

Claim 13: Williams and Briscoe disclose the method of claim 10. However, the references does not explicitly disclose wherein opening a user account with the vendor further comprises issuing a predetermined minimum number of electronic tokens to the user. Official notice is taken that the step of opening a user account with the vendor further comprises issuing a predetermined minimum number of electronic tokens to the user is old and well known within the art. One would have been motivated to including this step in order to increase the flexibility of the system.

Claim 14: Williams and Briscoe disclose the method of claim 1. However, the references does not explicitly disclose comprising issuing additional electronic tokens to the user. Official notice is taken that the step issuing additional electronic tokens to the user is old and well known within the art. One would have been motivated to including this step in order to increase the flexibility of the system.

Claim 16: Williams and Briscoe disclose the method of claim 14. Williams also discloses wherein issuing additional electronic tokens to the user comprises permitting the user to purchase additional electronic tokens through an on-line transaction using a credit card, without disrupting a process of selecting products and services (Col. 17, lines 49-57).

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Claim 17: Williams and Briscoe disclose the method of claim 1. Williams also discloses comprising displaying a number of available electronic tokens in the user account on a computer screen (Col. 18, lines 2-12).

Claim 18: Williams and Briscoe disclose the method of claim 1. Williams also discloses providing products and services that may be purchased through the vendor comprises providing software to be purchased or rented in exchange for electronic tokens (Col. 18, lines 2-12 and col. 32, line 57-col. 3, line 4).

Claim 19: Williams and Briscoe disclose the method of claim 18. However, the references does not explicitly disclose providing software to be purchased or rented comprises providing software that is rented for a limited time. Official notice is taken that the step providing software to be purchased or rented comprises providing software that is rented for a limited time is old and well known within the art. One would have been motivated to including this step in order to increase the number of the user's system.

Claim 20: Williams and Briscoe disclose the method of claim 18. However, the references does not explicitly disclose providing software to be purchased or rented comprises providing software that is rented for a limited number of uses. Official notice is taken that the step providing software to be purchased or rented comprises providing software that is rented for a limited number of uses is old and well known within the art.

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One would have been motivated to including this step in order to increase the number of the user's system.

Claim 21: Williams and Briscoe disclose the method of claim 18. However, the references does not explicitly disclose providing software to be purchased or rented comprises providing software that is rented for processing a given task for a specific number of times. Official notice is taken that the step providing software to be purchased or rented comprises providing software that is rented for processing a given task for a specific number of times is old and well known within the art. One would have been motivated to including this step in order to increase the number of the user's system.

Claim 22: Williams and Briscoe disclose the method of claim 18. However, the references does not explicitly disclose providing software to be purchased or rented further comprises permitting the user to extend the software rental in exchange for electronic tokens. Official notice is taken that this step is old and well known within the art. One would have been motivated to including this step in order to increase the number of the user's system.

Claim 23: Williams and Briscoe disclose the method of claim 18. However, the references does not explicitly disclose providing software to be purchased or rented further comprises permitting the user to convert rental software to purchased software in exchange for electronic tokens. Official notice is taken that this step is old and well

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known within the art. One would have been motivated to including this step in order to increase the number of the user's system.

Claim 24: Williams and Briscoe disclose the method of claim 18. Williams also discloses providing software to be purchased or rented further comprises determining if a selected software program is already installed on a user's computer, downloading and installing the selected software program if the selected software program is not already installed on the user's computer, and sending an authorization code, without downloading the selected software program, if the selected software program is already installed on the user's computer (Col. 1, lines 55-65 and col. 12, lines 10-40).

Claim 25: Williams and Briscoe disclose the method of claim 1. However, the references does not explicitly disclose comprising transferring electronic tokens from the user to a second user. Official notice is taken that this step is old and well known within the art. One would have been motivated to including this step in order to increase the number of the user's system.

Claim 26: Williams and Briscoe disclose the method of claim 1. Williams also discloses providing products and services that may be purchased through the vendor comprises listing products and services for sale by one or more users of a Web site maintained by the vendor (Col. 1, lines 39-52, col. 12, lines 49-51 and col. 13, lines 19-20).

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4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. (U.S. Patent No. 5,815,657) (hereinafter Williams) in view of Briscoe (U.S. Patent No. 6,341,273), and further view of Fujimoto (U.S. Patent No. 6,018,720).

Claim 15: Williams and Briscoe disclose the method of claim 14. However, the references do not explicitly disclose wherein issuing additional electronic tokens to the user comprises permitting the user to purchase additional electronic tokens if the user account does not contain enough electronic tokens to cover the total price of the selected subset of products and services. Fujimoto disclose such as step(Col. 3, lines 18-46). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to including this step. One would have been motivated to including this step in order to increase the flexibility of the system.

#### *Response to Arguments*

5. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

#### *Conclusion*

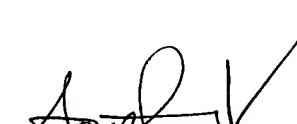
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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. Pedro R. Kanof whose telephone number is (703) 308-9552. The examiner can normally be reached on weekdays from 7:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Hyung Sough, can be reached on (703) 308-0505. The fax phone number for this Group is (703) 308-1396.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

PRK-9/26/03



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